


PATENT

Attorney Docket No. 27373/33716

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	"EXPRESS MAIL"
Whitley <i>et al.</i>)	mailing label No. EK657817535US
)	
U.S. Appl. No. 09/869,674)	Date of Deposit: December 27, 2001
)	
International Application No.:)	I hereby certify that this paper (or fee) is
PCT/US98/27902)	being deposited with the United States
)	Postal Service "EXPRESS MAIL POST
Intl. Filing Date: 13 December 2001)	OFFICE TO ADDRESSEE" service under
)	37 CFR §1.10 on the date indicated above
For: Recombinant Herpes Simplex)	and is addressed to: Commissioner for
Virus Useful for Treating)	Patents, Box PCT, Washington, D.C.
Neoplastic Disease)	20231
)	
Group Art Unit: Not yet assigned)	
)	Richard Zimmermann
Examiner: Not yet assigned)	
)	
)	

**RESPONSE TO "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371
IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)"**

Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

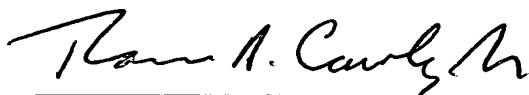
In response to the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (copy enclosed as Appendix A) dated 11 December 2001, the respectfully point out to the Patent Office that two inventors' declarations were previously forwarded to the Patent Office (along with the requisite fee) on November 15, 2001. Enclosed as Appendix B is a copy of the "Transmittal of Executed Inventors' Declarations to the United States Designated/Elected Office (DO/EO/US)" and

copies of the executed declarations attached thereto. Enclosed as Appendix C is copy of a self-addressed stamped postcard showing receipt of the aforementioned documents by the Patent Office.

In view of the foregoing, the applicants submit that as of November 15, 2001, all 35 U.S.C. §371 requirements had been met. Therefore, the applicants respectfully request that a notification of acceptance be forwarded to the undersigned as soon as possible.

Respectfully submitted,

MARSHALL, GERSTEIN, & BORUN



Thomas A. Cawley, Jr., Ph.D.
Registration No. 40,944
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402
312-474-6300

December 27, 2001

Appendix A



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/869,674	Whitley	27373/33716

INTERNATIONAL APPLICATION NO.

PCT/US98/27902

I.A. FILING DATE	PRIORITY DATE
------------------	---------------

12/31/1998

04743

MARSHALL, O'TOOLE, GERSTEIN, MURRAY & BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6402

CONFIRMATION NO. 8665

371 FORMALITIES LETTER



OC000000007176437

Date Mailed: 12/11/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of the International Application
- Copy of the International Search Report

RE.

DEC 11 2001

MARSHALL

Docketed: 2-11-02

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

PATRICIA A BOOKER

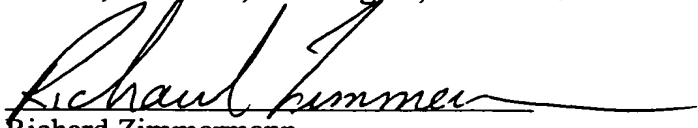
Telephone: (703) 305-3738

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/869,674	PCT/US98/27902	27373/33716

Appendix B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	"EXPRESS MAIL"
Whitley <i>et al.</i>)	mailing label No. EK657815070US
)	
U.S. Appl. No. 09/869,674)	Date of Deposit: November 15, 2001
)	
International Application No.:)	I hereby certify that this paper (or fee) is
PCT/US98/27902)	being deposited with the United States
)	Postal Service "EXPRESS MAIL POST
Filed: June 29, 2001)	OFFICE TO ADDRESSEE" service under
)	37 CFR §1.10 on the date indicated above
For: RECOMBINANT HERPES)	and is addressed to: Commissioner for
SIMPLEX VIRUS USEFUL)	Patents, Box PCT, Washington, D.C. 20231
FOR TREATING)	
NEOPLASTIC DISEASE)	
)	
Group Art Unit: Not yet assigned)	Richard Zimmermann
)	
Examiner: Not yet assigned)	
)	

**TRANSMITTAL OF EXECUTED INVENTORS' DECLARATIONS
TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

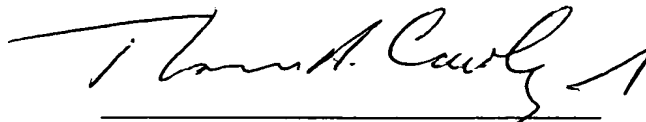
Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

Enclosed herewith are the executed inventors' declarations. Also enclosed herewith is the patent processing fee (\$130) pursuant to 37 C.F.R. §1.492(e), in view of the later filing of said declarations.

Respectfully submitted,

MARSHALL, GERSTEIN, & BORUN



Thomas A. Cawley, Jr., Ph.D.
Registration No. 40,944
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402
312-474-6300

November 15, 2001

DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **"RECOMBINANT HERPES SIMPLEX VIRUS USEFUL FOR TREATING NEOPLASTIC DISEASE,"** the specification of which was filed on June 29, 2001, as Application Serial No. 09/869,674 and which claims priority to International Patent Application NO. PCT/US98/27902 filed December 31, 1998. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

			Priority Claimed	
			<input type="checkbox"/>	<input type="checkbox"/>
(Application Serial Number)	(Country)	(Day/Month/Year Filed)	Yes	No
_____	_____	_____		
_____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>
(Application Serial Number)	(Country)	(Day/Month/Year Filed)	Yes	No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

_____	_____
(Application Serial Number)	(Day/Month/Year Filed)
_____	_____
(Application Serial Number)	(Day/Month/Year Filed)

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application:

PCT/US98/27902	31 December 1998	
(Application Serial Number)	(Day/Month/Year Filed)	(Status-Patented, Pending or Abandoned)
_____	_____	_____
(Application Serial Number)	(Day/Month/Year Filed)	(Status-Patented, Pending or Abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: I hereby appoint as my attorneys, with full power of substitution and revocation, to prosecute this application and transact all business in the Patent and Trademark Office connected herewith:

John B. Lungmus(18,566)
 Allen H. Gerstein (22,218)
 Nate F. Scarpelli (22,320)
 Michael F. Borun (25,447)
 Trevor B. Joiike (25,542)
 Carl E. Moore, Jr. (26,487)
 Richard H. Anderson (26,526)

Patrick D. Ertel (26,877)
 Richard B. Hoffman(26,910)
 James P. Zeller (28,491)
 Kevin D. Hogg (31,839)
 Jeffrey S. Sharp (31,879)
 Martin J. Hirsch (32,237)

James J. Napoli, Ph.D. (32,361)
 Richard M. La Barge (32,254)
 Douglass C. Hochstetler (33,710)
 Robert M. Gerstein (34,824)
 Anthony G. Sitko (36,278)
 James A. Flight (37,622)

Roger A. Heppermann (37,641)
 David A. Gass (38,153)
 Gregory C. Mayer (38,238)
 Michael R. Weiner (38,359)
 William K. Merkel, Ph.D. (40,725)
 Thomas A. Cawley, Jr., Ph.D. (40,944)

Send correspondence to: Thomas A. Cawley, Jr., Ph.D.

FIRM NAME	PHONE NO.	STREET	CITY & STATE	ZIP CODE
Marshall, Gerstein & Borun	312-474-6300	6300 Sears Tower 233 South Wacker Drive	Chicago, Illinois	60606-6402

Full Name of First or Sole Inventor Richard J. Whitley	Citizenship U.S.A.
Residence Address - Street 216 Shades Crest Circle	Post Office Address - Street 216 Shades Crest Circle
City (Zip) Birmingham 35216	City (Zip) Birmingham 35216
State or Country Alabama	State or Country Alabama
Date <input checked="" type="checkbox"/> August 23, 2001	Signature <input checked="" type="checkbox"/> <i>Richard J. Whitley</i>

Second Joint Inventor, if any Bernard Roizman	Citizenship U.S.A.
Residence Address - Street 5555 S. Everett	Post Office Address - Street 5555 S. Everett
City (Zip) Chicago 60637	City (Zip) Chicago 60637
State or Country Illinois	State or Country Illinois
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Third Joint Inventor, if any	Citizenship
Residence Address - Street	Post Office Address - Street
City (Zip)	City (Zip)
State or Country	State or Country
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Fourth Joint Inventor, if any	Citizenship
Residence Address - Street	Post Office Address - Street
City (Zip)	City (Zip)
State or Country	State or Country
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

APPLICABLE RULES AND STATUTES

37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith, in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **"RECOMBINANT HERPES SIMPLEX VIRUS USEFUL FOR TREATING NEOPLASTIC DISEASE,"** the specification of which was filed on June 29, 2001, as Application Serial No. 09/869,674 and which claims priority to International Patent Application NO. PCT/US98/27902 filed December 31, 1998. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

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(Application Serial Number)	(Country)	(Day/Month/Year Filed)	Yes	No
_____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>
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(Application Serial Number)	(Day/Month/Year Filed)
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Full Name of First or Sole Inventor Richard J. Whitley	Citizenship U.S.A.
Residence Address - Street 216 Shades Crest Circle	Post Office Address - Street 216 Shades Crest Circle
City (Zip) Birmingham 35216	City (Zip) Birmingham 35216
State or Country Alabama	State or Country Alabama
Date <input checked="" type="checkbox"/> Nov. 1 2001	Signature <input checked="" type="checkbox"/>

Second Joint Inventor, if any Bernard Roizman	Citizenship U.S.A.
Residence Address - Street 5555 S. Everett	Post Office Address - Street 5555 S. Everett
City (Zip) Chicago 60637	City (Zip) Chicago 60637
State or Country Illinois	State or Country Illinois
Date <input checked="" type="checkbox"/> Nov. 1 2001	Signature <input checked="" type="checkbox"/> [Signature]

Third Joint Inventor, if any	Citizenship
Residence Address - Street	Post Office Address - Street
City (Zip)	City (Zip)
State or Country	State or Country
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Fourth Joint Inventor, if any	Citizenship
Residence Address - Street	Post Office Address - Street
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- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Appendix C